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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/952, 741 11/25/97 HATADA

Y 2173-106P

EXAMINER

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HM12/0514

SLOBODYANSKY, E  
ART UNIT PAPER NUMBER

1652  
DATE MAILED:

05/14/99

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>08/952,741</b>	Applicant(s) <b>Hatada et al.</b>
	Examiner <b>Elizabeth Slobodyansky</b>	Group Art Unit <b>1652</b>

Responsive to communication(s) filed on February 26, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 2-19 is/are pending in the application.

Of the above, claim(s) 9, 11, and 17-19 is/are withdrawn from consideration.

Claim(s) 2, 5-7, and 12-14 is/are allowed.

Claim(s) 3, 4, 8, 10, 15, and 16 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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### **DETAILED ACTION**

The amendment filed February 26, 1999 (Paper No. 8) adding the abstract, canceling claim 1 and amending claims 2-5 and 9 has been entered.

The amendment includes the statement regarding the biological deposit (page 5, last paragraph).

#### ***Election/Restriction***

Applicant's election with traverse of Group I, claims 1-8, 10 and 12-16, in Paper No. 8 is acknowledged. The traversal is on the ground(s) that the instant application is a national stage of a PCT. This is not found persuasive because first, a 371 is subject to different requirements than lack of unity requirements in PCT and second, an  $\alpha$ -amylase is known in the prior art and, therefore, it does not make a contribution over the prior art.

The requirement is still deemed proper and is therefore made FINAL.

Claims 9, 11 and 17-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected Group II, the requirement having been traversed in Paper No. 8.

Claims 2-8, 10 and 12-16 are under consideration.

The text of those sections of Title 35 U.S. Code not included in this action can be found in a prior Office action.

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***Specification***

On page 10, line 16 and page 16, line 8, the specification refers to SEQ ID NO:1 where SEQ ID NO:2 is intended. Regarding Applicants' Remarks filed February 26, 1999 (page 3, second paragraph), the amendment filed September 11, 1998 has been entered and, as result, SEQ ID NO:2 has been amended to SEQ ID NO:1 where SEQ ID NO:2 is the correct identifier.

***Claim Rejections - 35 USC § 112***

Claims 3, 8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear what "translocated" means in the context of claim 3.

Claims 8 and 10 recite "the nucleic acid sequence of SEQ ID No. 2", while SEQ ID NO:2 is an amino acid sequence. Claims 8 and 10 are indefinite because the specific hybridization conditions are not recited and therefore, it is unclear what is within the scope of the claims.

In their Remarks filed February 26, 1999 Applicants note that claims 8 and 10 were amended to recite SEQ ID NO:1. Contrary to that, claims 8 and 10 were amended on September 11, 1998 to recite SEQ ID NO:2. Applicants argue that "there is nothing vague and indefinite about terminology "hybridizes to"" (page 6, 4th

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paragraph). While the term "hybridizes to" is understandable, the subject matter of the claim is not pointed out and distinctly claimed because which DNA will hybridize to a complement of SEQ ID NO:1 is indefinite if the hybridization conditions are unknown. In the present case Maniatis et al. is not incorporated by reference. If Maniatis et al. were incorporated by reference, incorporation should be limited, i.e, only certain specific conditions not all of Maniatis et al. should be incorporated.

***Claim Rejections - 35 USC § 102***

Claims 3, 4, 8, 10, 15 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsukamoto et al. or Yuuki et al.

This rejection was explained in the Office action mailed September 28, 1998. Applicants argue that the rejection is overcome in view of the amendment because a mutant  $\alpha$ -amylase "is equivalent in activity" to SEQ ID NO:2. Applicant's arguments have been fully considered but they are not persuasive. One  $\alpha$ -amylase is equivalent in activity to another  $\alpha$ -amylase unless the specific distinguishing characteristics are claimed.

The rejection of claim 1 under 35 U.S.C. 112, first paragraph, (written description) is withdrawn in view of the cancellation of claim 1.

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The rejection of claims 12 and 13 under 35 U.S.C. 112, first paragraph, is withdrawn in view of the statement regarding the availability of FERM BP-3048.

The rejection of claim 2 under 35 U.S.C. 112, second paragraph, is withdrawn in view of the amendment.

The rejection of claim 2 under 35 U.S.C. 103(a) is withdrawn in view of the amendment.

Claims 2, 5-7 and 12-14 are allowed.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth Slobodyansky whose telephone number is (703) 306-3222. The examiner can normally be reached Monday through Friday from 9:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Ponnathapura Achutamurthy, can be reached at (703) 308-3804. The FAX phone number for Technology Center 1600 is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Center receptionist whose telephone number is (703) 308-0196.

Elizabeth Slobodyansky, PhD

April 30, 1999



PONNATHAPURA ACHUTAMURTHY  
PRIMARY EXAMINER  
GROUP 1800